

| | |
|---|-----------|
| I. REAL PARTY IN INTEREST | 1 |
| II. RELATED APPEALS AND INTERFERENCES | 1 |
| III. STATUS OF CLAIMS..... | 2 |
| IV. STATUS OF AMENDMENTS | 2 |
| V. SUMMARY OF CLAIMED SUBJECT MATTER..... | 2 |
| VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL | 3 |
| VII. ARGUMENT..... | 3 |
| VIII. CLAIMS APPENDIX | 13 |
| IX. EVIDENCE APPENDIX | 15 |
| X. RELATED PROCEEDINGS APPENDIX | 16 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

| | | |
|-----------------------------|---|---------------------------|
| In re Application of | : | Customer Number: 46320 |
| | : | |
| Joshua AUERBACH, et al. | : | Confirmation Number: 5443 |
| | : | |
| Application No.: 10/017,728 | : | Group Art Unit: 2142 |
| | : | |
| Filed: December 14, 2001 | : | Examiner: D. Blair |
| | : | |
| For: MESSAGE FILTERING | : | |

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed November 24, 2006, wherein Appellants appeal from the Examiner's rejection of claims 8-14.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on February 27, 2002, at Reel 012661, Frame 0103.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 8-14 are pending and finally rejected in this Application, and claims 1-7 and 15 have been cancelled. It is from the final rejection of claims 8-14 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Fifth Office Action dated August 23, 2006 (hereinafter the Fifth Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 1, 4a, and 5a and also to independent claim 8, a method for receiving publications and forwarding the publications on to parties who have subscribed to receive such publications is disclosed. In step 200, a subscription request of a first type is received (page 16, lines 23-24 of Appellants' disclosure), and the request includes a filter expression having at least one attribute (page 17, lines 1-9). In step 220, at least part of the at least one attribute is mapped to a generic format (page 17, lines 9-10). In step 300, a publication message of a second type is received (page 18, lines 18-20). In step 350, the received publication message is compared to the subscription request to determine whether the publication message is appropriate for forwarding onto a subscriber originating the request (page 19, lines 13-16 and page 20, lines 2-5). In steps 240/320, a generic format filter attribute is identified (page 18, lines 5-7, lines 22-23). In steps 250/330, the generic format filter attribute is mapped to a format corresponding to the second message type (page 19, lines 10-13).

Referring to Figure 6a and also to dependent claim 10, the step of preparing the publication message for transmission to the originating subscriber includes creating a

substantially empty message of the first type in step 510 (page 20, lines 20-22). In step 520, information is extracted from the publication message of the second type (page 21, lines 1-3). In step 530, the information is inputted into the substantially empty message (page 21, lines 3-5). Referring to claim 11, the step of mapping at least part of an attribute to a generic format includes in step 240, invoking a first component capable of understanding messages of the first type (page 18, lines 1-7). Referring to claim 12, the generic format filter attribute is stored. Referring to claim 13, the step of mapping a generic format filter attribute to a format corresponding to the second message type includes, in step 330, invoking a second component capable of understanding messages of the second type (page 19, lines 4-9). Referring to claim 14, the format corresponding to the second message type is held in temporary storage until the comparison is complete.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 8-14 were rejected under 35 U.S.C. § 102 for anticipation based upon Herz, U.S. Patent No. 6,460,036.

VII. ARGUMENT

THE REJECTION OF CLAIMS 8-14 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON HERZ

For convenience of the Honorable Board in addressing the rejections, claim 9 stands or falls together with independent claim 8, and claims 10-14 each stand or fall alone.

At the outset, Appellants note that a Pre-Appeal Brief Request for Review was filed on November 23, 2005, and in this Pre-Appeal Brief Request, Appellants argued that the Examiner

failed to clearly identify many of the specific elements relied upon by the Examiner in rejecting the claims under 35 U.S.C. § 102 for anticipation based upon Herz. Based upon this Pre-Appeal Brief Request, prosecution was reopened and the Examiner presented additional analysis to support the Examiner's rejection of the claims under 35 U.S.C. § 102 for anticipation based upon Herz in a Third Office Action dated April 25, 2006. However, in responding to the Third Office Action, Appellants argued that the Examiner has again failed to identify many of the specific elements relied upon by the Examiner in rejecting the claims under 35 U.S.C. § 102 for anticipation based upon Herz as required by 37 C.F.R. § 1.104(c).¹ Moreover, Appellants presented individual arguments as to claims 8, 10, and also to claims 11-14, as a group. The Examiner's response to these arguments are found on pages 4 and 5 of the Fifth Office Action and is reproduced below:

12. Applicants arguments filed 7/25/2006 have been fully considered but they are not persuasive. The applicant's main argument is that there is no apparent teaching within the cited section of Herz that a subscription request includes a first expression having at least one attribute and the examiner did not address the applicant's prior argument that the "Examiner is confusing 'specifying search parameters' with 'subscription requests'". In response the examiner points out that the Herz invention is directed towards providing information to subscribers so the search parameters provided by the user are considered subscription requests because the search parameters are used by the user to subscribe to various information sources. Merely stating that Herz does not teach a subscription request without elaborating on how the subscription request in the context of the applicant's invention is different from Herz does nothing to further prosecution because the examiner believes that Herz teaches a subscription request and would not have set the rejection forth otherwise.

Reproduced below are the arguments previously presented by Appellants in response to the Examiner's rejection of the claims based upon Herz. As will be noted below, the Examiner has failed to address many of these arguments in the Fifth Office Action. Moreover, for those

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

arguments that the Examiner has addressed, the Examiner does little more than assert that the Examiner disagrees.

Claim 8

Independent claim 8, as originally presented, recites "receiving a subscription request of a first type, said request including a filter expression having at least one attribute," and on page 2 of the Fifth Office Action regarding this limitation, the Examiner cited column 4, line 49 through column 5, line 7 of Herz and asserted "the search profile or query contains keywords and target objects to request publications of interest." For ease of reference, column 4, line 49 through column 5, line 7 of Herz is reproduced below:

Relevant definitions of terms for the purpose of this description include: (a.) an object available for access by the user, which may be either physical or electronic in nature, is termed a "target object", (b.) a digitally represented profile indicating that target object's attributes is termed a "target profile", (c.) the user looking for the target object is termed a "user", (d.) a profile holding that user's attributes, including age/zip code/etc. is termed a "user profile", (e.) a summary of digital profiles of target objects that a user likes and/or dislikes, is termed the "target profile interest summary" of that user, (f) a profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this collection, of attributes, is termed a "search profile" or in some contexts a "query" or "query profile," (g.) a specific embodiment of the target profile interest summary which comprises a set of search profiles is termed the "search profile set" of a user, (h.) a collection of target objects with similar profiles, is termed a "cluster," (i.) an aggregate profile formed by averaging the attributes of all target objects in a cluster, termed a "cluster profile," (j.) a real number determined by calculating the statistical variance of the profiles of all target objects in a cluster, is termed a "cluster variance," (k.) a real number determined by calculating the maximum distance between the profiles of any two target objects in a cluster, is termed a "cluster diameter."

This passage cited by the Examiner does not teach anything with regard to receiving a subscription request of a first type, as recited in claim 8. Instead, the passage cited by the Examiner is just a collection of terms that the Herz has deemed to define.

Regarding the Examiner's specific assertion that "the search profile or query contains keywords and target objects to request publications of interest," although in definition (f), Herz

teaches "a profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this collection, of attributes, is termed a 'search profile' or in some contexts a 'query' or 'query profile,'" Herz fails to teach that keywords and target objects are found in a subscription request, as recited in claim 8. Thus, there is no apparent teaching within this passage that a subscription request includes a first expression having at least one attribute, as recited in claim 8.

Moreover, Appellants are unable to determine where, within this passage, Herz teaches the claimed receiving a subscription request of a first type. This passage within Herz is silent as to a subscription request, and thus, is also silent as to a "first type" of a subscription request. Therefore, the Examiner has failed to establish that Herz identically discloses the above-reproduced claimed invention within the meaning of 35 U.S.C. § 102.

The above argument is the alleged "main argument," as asserted by the Examiner on page 4 of the Fifth Office Action. Although the Examiner asserts that "the search parameters provided by the user are considered subscription requests because the search parameters are used by the user to subscribe to various information sources," the Examiner has failed to provide any factual evidence that supports a conclusion that one having ordinary skill in the art, given the ordinary and customary meaning attributed to this phrase, would have considered that the search parameters provided by the user as identically disclosing the claimed "subscription request of a first type, said request including a filter expression having at least one attribute." Appellants also note that the Examiner's comments are silent as to what constitutes a "subscription request of a first type."

It is readily apparent that the Examiner cannot assert that Herz explicitly teaches the claimed "subscription request of a first type, said request including a filter expression having at least one attribute." Thus, the Examiner must be relying upon an inherency argument to establish that Herz identically discloses this limitation. However, such a reliance upon the doctrine of inherency to disclose the limitation at issue would be misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.² To establish inherency, the extrinsic evidence must make clear that the missing element or function must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.³ Furthermore, reference is made to ex parte Schricker,⁴ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where such a teaching or suggestion appears in the prior art. As can be readily envisaged, a subscriber in Herz could submit a subscription request that is completely separate from the search parameters that are used.

² In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

³ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

⁴ 56 USPQ2d 1723, 1725 (BPAI 2000).

Therefore, for the reasons stated above, the Examiner has not established that this limitation is inherently disclosed by Herz.

In the Amendment filed July 25, 2006 (hereinafter the Amendment), Appellants further noted that independent claim 8, as amended, recites "mapping at least part of the at least one attribute to a generic format," and in the statement of the rejection regarding this limitation, the Examiner cited column 57, lines 39-51, which for ease of reference is reproduced below:

Rather than carry out steps 5-9 of the above process separately for each search profile of each user, it is possible to achieve added efficiency by carrying out these steps only once for each group of similar search profiles, thereby satisfying many users' needs at once. In this variation, the system begins by non-hierarchically clustering all the search profiles in the search profile sets of a large number of users. For each cluster k of search profiles, with cluster profile p_k , it uses the method described in the section "Searching for Target Objects" to locate articles with target profiles similar to p_k . Each located article is then identified as of interest to each user who has a search profile represented in cluster k of search profiles.

Upon reviewing this passage, Appellants are unclear as to where, within this passage, Herz teaches mapping at least part of the at least one attribute to a generic format. Specifically, Appellants are unable to determine what feature within Herz identically discloses the claimed (i) generic format; (ii) the at least one attribute; and (iii) the mapping.

The Examiner did not directly address this argument in the Fifth Office Action.

As yet another example, independent claim 8, as originally presented, recites "receiving a publication message of a second type," and in the statement of the rejection regarding this limitation, the Examiner again cited column 4, line 49 through column 5, line 7 of Herz and asserted "the target profile." Upon reviewing this cited passage, which has already been reproduced above, Appellants are unclear as to how the teaching of "the target profile" identically discloses the claimed "receiving a publication message of a second type." Definition

(b) of Herz states that "a digitally represented profile indicating that target object's attributes is termed a 'target profile'," which is silent as to both a "second type" and "receiving a publication message."

The Examiner did not directly address this argument in the Fifth Office Action.

Independent claim 8, as amended, further recites "comparing the publication message received to the subscription request to determine whether the publication message is appropriate for forwarding onto the subscriber originating the request," and in the statement of the rejection regarding this limitation, the Examiner cited column 57, lines 8-36 and asserted "the search profile is compared with the target profile." In this regard, Appellants incorporate herein the arguments previously presented in the Pre-Appeal Brief Request for Review dated November 23, 2005. Specifically, reference is made to arguments entitled, "Examiner confusing 'specifying search parameters' with 'subscription request'," which are found in the paragraph spanning pages 3 and 4 and the first full paragraph on page 4. Appellants' arguments, however, were not addressed by the Examiner in the Fourth Office Action. In this regard, the Examiner is referred to M.P.E.P. § 707.07(f), which states that "the Examiner, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

As reproduced above, the Examiner stated the following in the Fifth Office Action:

Merely stating that Herz does not teach a subscription request without elaborating on how the subscription request in the context of the applicant's invention is different from Herz does nothing to further prosecution because the examiner believes that Herz teaches a subscription request and would not have set the rejection forth otherwise.

Since "specifying search parameters," as taught by Herz is not identical to the claimed "subscription request," the initial burden rests with the Examiner to provide a claim construction for the claimed "subscription request" and explain why the teachings of Herz identically discloses this limitation. This burden has not been met, and in so doing, the Examiner has failed to establish a prima facie case of anticipation.

Independent claim 8, as originally presented, also recites "identifying a generic format filter attribute," and in the statement of the rejection regarding this limitation, the Examiner cited columns 57 and 58 and asserted "the target profile." Appellants note, however, that the Examiner also asserted that the claimed "receiving a publication message of a second type" is also disclosed by "the target profile." In this regard, Appellants are unclear as to how the Examiner can assert that the same taught feature (i.e., the target profile) can teach both "identifying a generic format filter attribute" and "receiving a publication message of a second type," as recited in claim 8.

The Examiner did not directly address this argument in the Fifth Office Action.

Claim 10

Dependent claim 10 recites:

creating a substantially empty message of said first type;
extracting information from the publication message of said second type; and
inputting said information into said substantially empty message.

On page 3 of the Fifth Office Action, the Examiner only asserted "the search profiles can contain few keywords or target objects" and "attributes are examined from the target profiles." Based upon these assertions, Appellants are unclear as to why the Examiner believes the above-reproduced limitations recited in claim 10 are identically disclosed by Herz since the Examiner's comments and the claimed limitations appear to be completely different.

The Examiner did not directly address this argument in the Fifth Office Action.

Claims 11-14

With regard to these limitations, the Examiner merely cites column 56, line 49 through column 57, line 5 or asserts "the [target/search] profiles are analyzed as described above." This "analysis" by the Examiner again fails to clearly identify the specific elements within Herz being relied upon in the rejection.

The Examiner did not directly address this argument in the Fifth Office Action. The Examiner, however, generically addressed these arguments in the thirteenth enumerated paragraph on page 5 of the Fifth Office Action, in which the Examiner asserted the following:

13. The applicant further argues that the examiner has not clearly shown the rest of the claim limitations, however, the examiner feels that the rejection based on Herz clearly shows how Herz anticipates the claim language. If the applicant is still having trouble understanding the current rejections, the examiner invites the applicant to call the examiner so that the examiner can explain the rejections to the applicant. At that point the applicant can decide whether to make an amendment or how to argue that the limitations of the claims with respect to the applicant's invention are different from Herz.

The Examiner has rejected the claims under 35 U.S.C. 102 for anticipation based upon Herz since the first Office Action dated March 1, 2005. In each of the Appellants' responses to the first four Office Actions, Appellants have argued that the Examiner has failed to establish that Herz

identically discloses the claimed invention. The Examiner, however, has continually failed to specifically address Appellants' arguments. Moreover, the above-reproduced paragraph is essentially a blanket disagreement with the extensive arguments presented above with regards to claims 8, 10, and 11-14 without a clear explanation as to why the Examiner disagrees.

Therefore, for the reasons stated above, Appellants submit that the imposed rejection of claims 8-14 under 35 U.S.C. § 102 for anticipation based upon Herz is not factually viable.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102 based upon the applied prior art is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: January 24, 2007

Respectfully submitted,

/Scott D. Paul/
Scott D. Paul
Registration No. 42,984
Steven M. Greenberg
Registration No. 44,725
CUSTOMER NUMBER 46320

VIII. CLAIMS APPENDIX

8. A method for receiving publications and forwarding said publications on to parties who have subscribed to receive such publications, said method comprising:

receiving a subscription request of a first type, said request including a filter expression having at least one attribute;

mapping at least part of the at least one attribute to a generic format;

receiving a publication message of a second type;

comparing the publication message received to the subscription request to determine whether the publication message is appropriate for forwarding onto a subscriber originating the request, the step of comparing comprising:

identifying a generic format filter attribute; and

mapping the generic format filter attribute to a format corresponding to the second message type, the method further comprising:

transmitting said publication message to the originating subscriber.

9. The method of claim 8, further comprising:

preparing the publication message for transmission to said originating subscriber.

10. The method of claim 9, wherein the step of preparing the publication message for transmission to said originating subscriber comprises:

creating a substantially empty message of said first type;

extracting information from the publication message of said second type; and

inputting said information into said substantially empty message.

11. The method of claim 8, 9 or 10, wherein the step of mapping at least part of an attribute to a generic format comprises:

invoking a first component capable of understanding messages of said first type.

12. The method of claim 8, 9 or 10, comprising:

storing said generic format filter attribute.

13. The method of any of claims 8, 9 or 10, wherein the step of mapping a generic format filter attribute to a format corresponding to the second message type comprises:

invoking a second component capable of understanding messages of said second type.

14. The method of any of claims 8, 9 or 10, wherein said format corresponding to the second message type is held in temporary storage until said comparison is complete.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.